

ESTTA Tracking number: **ESTTA607051**

Filing date: **05/29/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

| | | | |
|---------|--|-------------|------------|
| Name | Grange Insurance Association | | |
| Entity | Corporation | Citizenship | Washington |
| Address | 200 Cedar Street Seattle, WA 98121 UNITED STATES | | |

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| Correspondence information | John Crosetto Garvey Schubert Barer 1191 Second Avenue Suite 1800 Seattle, WA 98101 UNITED STATES trademarks@gsblaw.com Phone:206-464-3939 |
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Registrations Subject to Cancellation

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|-----------------|---|-------------------|------------|
| Registration No | 3821201 | Registration date | 07/20/2010 |
| Registrant | Grange Mutual Casualty Company 650 South Front Street Columbus, OH 43206 UNITED STATES | | |

Goods/Services Subject to Cancellation

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| Class 036. First Use: 1987/12/00 First Use In Commerce: 1987/12/00 All goods and services in the class are cancelled, namely: Insurance services, namely, insurance underwriting in the field of auto, home, farm, business, life, property, casualty, accident, health, disability, annuities |
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Grounds for Cancellation

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| False suggestion of a connection | Trademark Act section 2(a) | | |
| <i>Torres v. Cantine Torresella S.r.l.Fraud</i> | 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986) | | |
| Priority and likelihood of confusion | Trademark Act section 2(d) | | |
| Registration No | 3723315 | Registration date | 12/08/2009 |
| Registrant | Grange Mutual Casualty Company 650 South Front Street Columbus, OH 43206 UNITED STATES | | |

Goods/Services Subject to Cancellation

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| Class 036. First Use: 2009/02/23 First Use In Commerce: 2009/02/23 All goods and services in the class are cancelled, namely: Insurance services, namely, insurance underwriting in the field of auto, home, farm, business, life, property, casualty, accident, health, disability, annuities |
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| ity, annuities |
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Grounds for Cancellation

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| False suggestion of a connection | Trademark Act section 2(a) |
| <i>Torres v. Cantine Torresella S.r.l.Fraud</i> | 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986) |
| Priority and likelihood of confusion | Trademark Act section 2(d) |

Mark Cited by Petitioner as Basis for Cancellation

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| U.S. Application No. | 86080560 | Application Date | 10/02/2013 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | GRANGE INSURANCE ASSOCIATION | | |
| Design Mark |  | | |
| Description of Mark | The mark consists of the words GRANGE INSURANCE above the word ASSOCIATION. Over the words is an arch which appears to be divided into two sections. | | |
| Goods/Services | Class 036. First use: First Use: 0 First Use In Commerce: 0 Property and casualty insurance services | | |

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| Attachments | 86080560#TMSN.jpeg(bytes) Signed Cancellation Actionre GRANGE Trademark.pdf(464340 bytes) |
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|-----------------|
| Signature | /John Crosetto/ |
| Name | John Crosetto |
| Date | 05/29/2014 |

IN THE UNITED STATES PATENT AND
TRADEMARK OFFICE BEFORE THE TRADEMARK
TRIAL AND APPEAL BOARD

Grange Insurance Association,

Petitioner,

vs.

Grange Mutual Casualty Company,

Respondent.

PETITION FOR CANCELLATION

Cancellation No. _____

Petitioner, Grange Insurance Association, a Washington corporation located and doing business at 200 Cedar Street, Seattle, Washington 98121 believes that it is or will be damaged by Registration Number 3821201 for the mark GRANGE INSURANCE and Registration Number 3723315 for the mark GRANGE INSURANCE and Design, both in Class 36. Petitioner hereby petitions to cancel said registrations.

The grounds for this Petition are as follows:

Grounds for Cancellation

1. Petitioner, Grange Insurance Association, is a Washington corporation, located and doing business at 200 Cedar Street, Seattle, Washington 98121.

2. Applications for Registration Number 3821201 for the mark GRANGE INSURANCE and Registration Number 3723315 for the mark GRANGE INSURANCE and Design, claiming "Insurance services, namely, insurance underwriting in the field of auto, home, farm, business, life, property, casualty, accident, health, disability, annuities," in International Class 36, were filed on 3 December 2009 and 6 August 2008,

respectively, by Grange Mutual Casualty Company (“Respondent”). Registration Number 3821201 for the mark GRANGE INSURANCE claims priority as of 31 December 1987, and Registration Number 3723315 for the mark GRANGE INSURANCE and Design claims priority as of 23 February 2009.

3. Since at least as early as 1936, Petitioner has adopted and used the mark GRANGE (with variations in additional wording or designs) in connection with insurance services in the US, and since at least as early as 1943, Petitioner has adopted and used the mark GRANGE INSURANCE ASSOCIATION in connection with insurance services in the US. Petitioner has US common law rights in the GRANGE and GRANGE INSURANCE ASSOCIATION marks based on such use.

4. For many years, starting in 1963, both Respondent and Petitioner have participated in the National Federation of Grange Mutual Insurance Companies and have been aware of the respective uses and rights of the other in the GRANGE mark in connection with insurance services.

5. Petitioner has also, on October 2, 2013, filed trademark application Serial No. 86/080560 for the mark GRANGE INSURANCE ASSOCIATION and Design based upon a bona fide intent-to-use, seeking registration in connection with “property and casualty insurance services” in Class 36.

6. On December 9, 2013, the Trademark Examining Attorney in Petitioner’s above-noted GRANGE INSURANCE ASSOCIATION application, Serial No. 86/080560, issued an Office Action refusing registration to Petitioner under Section 2(d) of the Trademark Act based upon Registration No. 3821201, Registration No. 3723315, and others (all owned by Respondent).

Priority and Likelihood of Confusion

7. Petitioner hereby restates allegations 1 through 6 as if made fully herein below.

8. On information and belief, Petitioner believes that Application Serial No. 86/060560 should not be refused based on Respondent's marks as Petitioner has priority of rights in the GRANGE INSURANCE ASSOCIATION mark based upon long-standing common law use of the GRANGE and GRANGE INSURANCE ASSOCIATION marks (and variations) in connection with insurance services in the US.

9. Petitioner has expended considerable time, effort, and expense in promoting, advertising, and offering the insurance services under its GRANGE and GRANGE INSURANCE ASSOCIATION marks, and has developed and enjoys a favorable reputation and valuable goodwill in its marks, which identify, distinguish, and indicate the source of Petitioner's insurance services.

10. Petitioner has used the GRANGE INSURANCE ASSOCIATION mark for more than 43 years prior to the alleged priority date based on Respondent's registrations. Consequently, Petitioner's common law rights have priority over Respondent's registrations as a result of Petitioner's earlier continuous use of its GRANGE INSURANCE ASSOCIATION mark.

11. Respondent's GRANGE INSURANCE marks are highly similar to Petitioner's GRANGE INSURANCE ASSOCIATION mark. Both marks begin with the distinctive word GRANGE and are followed by the word INSURANCE.

12. Respondent's claimed services are identical to and/or overlap with Petitioner's services, and are offered to identical and/or overlapping customer types and market segments.

13. The net effect of these similarities in marks, services, and customer types is that the marks appear and sound confusingly similar, especially when encountered in the marketplace, and are offered in the same channels of trade.

14. The clear visual and phonetic similarities between the marks in question, as well as the close similarities between the services and customers offered and targeted by the respective marks has resulted in the relevant public mistakenly believing that Respondent's services under the GRANGE INSURANCE marks are sponsored, endorsed, or approved by Petitioner, or are in some way affiliated, connected, or associated with Petitioner all to the detriment of Petitioner.

15. By virtue of the foregoing, Respondent's registrations should be cancelled under Section 2(d) of the Lanham Act, 15 USCA Section 1052(d), given Petitioner's seniority of use and priority of rights in the GRANGE INSURANCE ASSOCIATION mark. If Respondent retains such rights as conferred under the Principal Register of the Trademark Act of 1946, Petitioner will be subject to great and irreparable damage in that it will be unable to federally register its GRANGE INSURANCE ASSOCIATION mark, and Respondent will enjoy an advantage to which it is not entitled under the Trademark Act of 1946.

Knowingly False Statement in Applications

16. Petitioner hereby restates allegations 1 through 15 as if made fully herein below.

17. The US Trademark Office requires trademark applicants to declare that “to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive.”

18. Since at least as early as 1943, the name under which Petitioner has offered its insurance services has been Grange Insurance Association, and on information and belief, since at least as early as 1963, Respondent has been aware of Petitioner’s use of its GRANGE and GRANGE INSURANCE ASSOCIATION marks.

19. On information and belief, Petitioner believes that Registration No. 3821201 and Registration No. 3723315 should be cancelled as Respondent made a material, fraudulent declaration despite knowing and having known, that it does not have, and has not had, exclusive or a priority of rights in the GRANGE INSURANCE mark throughout the United States, and that as of the date of filing of applications for Registration Nos. 3821201 and 3723315, Respondent was aware that it was not the only entity entitled to use or have rights in such mark in commerce in the US in connection with insurance services and that Petitioner had prior rights.

20. By virtue of the foregoing, if Respondent retains such rights as conferred under the Principal Register of the Trademark Act of 1946, Petitioner will be subject to great and irreparable damage in that it will be unable to federally register its GRANGE INSURANCE ASSOCIATION mark, and Respondent will enjoy an advantage in scope of rights to which it is not entitled under the Trademark Act of 1946.

Prayer for Relief

WHEREFORE, the Petitioner, Grange Insurance Association, believes and avers that it is being damaged and will continue to be damaged by the continued registration of the subject GRANGE INSURANCE and GRANGE INSURANCE and Design trademarks, Registrations No. 3821201 and 3723315, as aforesaid, and prays that the Trademark Trial and Appeal Board:

- (a) Sustain the petition for cancellation and render judgment for Petitioner;
 - (b) Order that Registrations No. 3821201 and 3723315 be cancelled forthwith;
- and
- (c) For such other and further relief as is deemed appropriate.

Respectfully submitted,

GARVEY, SCHUBERT & BARER

Attorneys for Petitioner
1191 Second Avenue, Suite 1800
Seattle, Washington 98101
(206) 464-3939
trademarks@gsblaw.com

By: 

John Crosetto

Dated: May 29, 2014
Ref: 09208-65000

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Petition for Cancellation was served via first class mail, postage prepaid, upon Respondent's Attorney of Record:

Cory M. Amron
VORYS, SATER, SEYMOUR AND PEASE LLP
P. O. Box 2255
Columbus, Ohio 43216-2255

This 29th day of May, 2014

A handwritten signature in blue ink, reading "Dana M. Hanson", is written over a horizontal line.